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| 08/100,010      | 07/30/93    | TRICK                | TRICK201W           |

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EXAMINER  
DALAKIS, M

ART UNIT  
2851

PAPER NUMBER

DATE MAILED: 08/08/93

Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES DEPARTMENT OF COMMERCE  
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 36

Application Number: 08/100,019  
Filing Date: July 30, 1993  
Appellant(s): Trick

MAILED

JUL 1993

GF

\_\_\_\_\_  
Kurt G. Briscoe  
For Appellant

**EXAMINER'S ANSWER**

This is in response to appellant's brief on appeal filed May 17, 1999.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3)     *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4)     *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5)     *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6)     *Issues***

The appellant's statement of the issues in the brief is correct.

**(7)     *Grouping of Claims***

Appellant's brief includes a statement that claims 1-8 and 10-17 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8)     *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9)     *Prior Art of Record***

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

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|           |       |        |
|-----------|-------|--------|
| 1,933,953 | Ames  | 8-1932 |
| 4,304,471 | Jones | 8-1981 |
| 4,827,291 | Guez  | 5-1989 |

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 7 and 15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant's claimed feature of having "each second exposed portion in the package already being developed" lacks an enabling disclosure in the specification. It is not understood, or discussed in Applicant's specification, how a 35mm or Polaroid/instant type film is partially developed without also developing the area of the photographic film utilized for later recording. Applicant asserts that "methods for developing only portions of photographic frames were well known in the art at the time the invention was made." The examiner has not found support for this statement in the art. The distinction between pre-exposed and partially previously developed film is significant and applicant (e.g. page 6, lines 10-13 of amendment of 6-26-98) has consistently referred to film "as here, the film is intended to be sold partially exposed." Applicant is therefore required to submit such evidence of this commonly known pre-partially developed technique.

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Claims 1-3, 6, 8, 10, 11, 14, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by either Ames or Guez. With respect to claims 1-3, 6, 8, 10, 11, 14, 16 and 17, Ames and Guez each disclose all aspects of said claims. Applicant should note that both Ames (column 4, line 107 through column 5, line 8) and Guez (column 10, line 30 through column 11, line 67) each disclose photographic film containing frames which have a previously exposed "border" area, as well as an unexposed portion for future image recording.

Claims 4, 5, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by either Ames or Guez, or, in the alternative, under 35 U.S.C. 103(a) as obvious over either Ames or Guez in view of Jones. With respect to claims 4, 5, 12 and 13, applicant states that "the package is of instant developing film." Interpreted broadly, all film which is subjected to, and capable of, developing immediately or soon after exposure can be considered to be "instant developing film", and therefore Ames and Guez disclose all aspects of said claims. Alternatively, however, if applicant's claim language is read as specifically referring to Polaroid type film, then Ames and Guez disclose all aspects of said claims with the exception of specifically disclosing the use of Polaroid type film. Jones, however, does disclose just such Polaroid type film which utilizes masks for creating decorative borders around an object to be photographed. Given that Ames, Guez and Jones each disclose devices of similar form and function, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize Jones' teaching of utilizing masks to create decorative borders, in conjunction with Ames' and Guez's teaching of masks for the creation of pre-exposed

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borders on photographic film, for the purposes of providing instant Polaroid type film with a myriad of decorative border options, where said borders have already been exposed.

This rejection is set forth in prior Office action, Paper No. 29.

**(11) *Response to Argument***

With regard to the Section 112 rejections, the applicant provides three obvious and known methods which entail simple, relatively uncomplicated procedures that would have occurred to any person skilled in the art. The first two methods presented by the applicant involve *separately* pre-exposing the "second" portion of the film at the factory prior to sealing the film package. However, this is not clearly claimed in the present claims. From the present claim language it appears that the "second exposed portion" is developed while attached to the "first exposed portion." This type of selective development, which seems to be recited in the claim language, is far from obvious to one of ordinary skill in the art. The applicant's third obvious method is a complex chemical development method which is not at all obvious to one of ordinary skill in the art.

With respect to the prior art rejections, the applicant first argues that all of the instant claims require a "sealed" package of photographic film as recited in lone independent claim 1. The applicant then goes on to assert that this requires the film to have "been placed into a package and sealed." Thus, the applicant follows, neither Ames nor Guez can anticipate the claimed invention. The applicant has stated that a sealed package of film is claimed, wherein the film in the package is already exposed on a portion of each of the photographic frames.

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With specific regard to the Ames reference, the applicant argues that since Ames discloses the use of sensitized positive paper and not photographic film, it cannot anticipate "a sealed package of film" as claimed. The examiner believes that sensitized positive paper functions as instant photographic film and thus can anticipate the broadly claimed present invention. The applicant then argues that since the Ames patent describes a complex apparatus which uses two successive cameras, there is no teaching of a sealed package of film or a even a need for packaging partially exposed film. The sealed package of Ames comprises the light sealed box B and receptacle R. In column 3, lines 24-26, it is specifically disclosed that no exposure to light is permitted within these two housings. The examiner does not understand the applicant's argument regarding the need for packaging partially exposed film. The present claims only require a sealed package of film with an exposed and unexposed portion. This is clearly anticipated by the disclosure in the Ames patent.

With regard to the Guez patent, the applicant states that since Guez requires a complex scheme including rewinding the film after the pre-exposure of a portion of the film but does not package the film prior to rewinding, it cannot anticipate the present invention. The examiner does not agree with the applicant's interpretation of the Guez reference. Once the film is rewound (after the first pre-exposure operation) into the film cartridge, the result is an inherently (light) sealed package of photographic film with an exposed portion and an unexposed portion. If the package was not sealed from exposure to light it would clearly not function as photographic film. Furthermore, nowhere in present claims is it recited that

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between exposures the film is packaged and sealed as the applicant argues. The applicant's arguments are much broader than the claim language of the present invention.

Finally, with respect to the section 103 rejection, the applicant argues that Jones fails to overcome the prejudice established by Guez and Ames of preparing the composite photograph "without intermediate packaging and sealing of the partially exposed film." Once again the applicant is arguing features that are just not present in the claim language. There is no recitation of intermediate packaging and sealing of partially exposed film. The claims merely recite a sealed package of photographic film having an exposed portion and an unexposed portion.



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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

MD

June 7, 1999

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A handwritten signature in dark ink, appearing to read "P. M. Sprung", is written over a faint, circular official stamp. The signature is fluid and cursive.